PROPOSED COUNT

A method of performing a surgical procedure for the removal or repair of biological tissue comprising the steps of:

generating a laser beam having a wavelength of between 1.4 and 2.2 microns;

directing the beam into one end of a fiber optic cable, with the other end of the fiber optic cable defining the delivery end thereof;

positioning the delivery end of the fiber optic cable at the surgical site; and

irrigating the surgical site with a liquid medium.

Claims 1-6 of U.S. Patent No. 5,037,421 correspond to the proposed count. Newly added claims 71-76 in the present application correspond to the proposed count, and Claim 71 is identical to the proposed count. Claims 71 and 76 were substantially copied from Claim 1 of the '421 patent, and Claims 72-75 were substantially copied from Claims 2, 3, 4, and 6 respectively of the '421 patent. Claim 1 of the '421 patent and new claims 71 and 76 herein claim the same patentable invention.

As can be seen, the proposed count does not correspond exactly to Claim 1 of the '421 patent. The proposed count is broader in several respects. In the first place, the preamble has been changed from "A method of performing an arthroscopic procedure" in the '421 patent to--A method of performing a surgical procedure for the removal or repair of biological

tissue--in the count. It is clear from the '421 patent that the process of performing an arthroscopic procedure is simply the surgical removal or repair of tissue in a joint. See for example in the '421 patent column 1, line 28; column 1, lines 36-39; column 2, lines 16-18 (refers to ablation of the tissue); column 2, lines 27-30; column 2, lines 47-62 (refers to ablation craters and tissue cutting). Applicant's application is directed to tissue repair or tissue removal generally, and does not specifically discuss an arthroscopic procedure. However, both the present application and the '421 patent relate to the same patentable invention, i.e. the repair or removal of body tissue with a laser and the proposed preamble is the most suitable as it encompasses an arthroscopic procedure within its scope. In addition, the recited wavelength range of 1.8-2.2 microns in the '421 patent has been changed to 1.4 to 2.2 microns. The claimed wavelength range in the patent is within applicant's claimed wavelength range, and within the range recited in the count, both of which are broader, and constitutes the same patentable invention. The recitation "adjacent the tissue to be ablated by the laser beam" has been changed to "at the surgical site." Again, the latter recitation is broader than the patent claim and recites the same patentable invention. Applicant herein does not specificly use the words "tissue to be ablated" in his application but does refer to a surgical site.

The last element of the patent claim also is different from the comparable element in the count. The word "tissue" has been changed to--surgical site--for the reasons discussed above. The following recitation does not appear in the count: "as it is being ablated by a laser beam." The irrigation of tissue with a liquid medium as it is being ablated by a laser beam is old in the art, and is taught specifically in U.S. Patent No. 4,448,188 (Loeb) and in U.S. Patent No. 4,732,448 (Goldenberg), copies of which are enclosed herewith. Both patents teach irrigation of a surgical site during the ablation process, and Loeb specifically teaches such irrigation when using a laser operating at infrared wavelengths. For example see Loeb, column 2, lines 13-31; column 4, lines 4-64; column 9, lines 60-63; and Goldenberg, column 3, lines 29-38; and column 8, lines 30-46. Since this element is old in the art, it is not a patentable limitation, even though it was argued to be so by the applicant during prosecution of the '421 patent. Thus, this limitation does not appear in the proposed count, or in applicant's corresponding claims.

The following is an application of each term of Claims 71 and 76 to the above-identified application:

| Elements of Claims 71 & 76 | Support in Application Serial No. 568,348 |
|---|---|
| 1. A method of performing a surgical procedure for the removal or repair of biological tissue | Page 6, lines 12-25. |
| 2. generating a laser beam having a wavelength of between 1.4 and 2.2 microns | Page 6, lines 2-6. |
| 3. directing the beam into one end of a fiber optic cable | Page 13, lines 12-15. |
| 4. with the other end of the fiber optic cable defining the delivery end thereof | Page 13, lines 19-22; Page 15, lines 11-14. |
| 5. (Claim 71) positioning the delivery end of the fiber optic cable at the surgical site<br><br>(Claim 76) positioning the delivery end of the fiber optic cable adjacent the tissue to be removed or repaired by the laser beam | Page 1, lines 13-21; Page 14, lines 17-25; Page 21, lines 21-23; Page 31, lines 1 & 2; Column 9, lines 3-16 of U.S. Patent No. 4,850,351, specifica- of which is incorpor- ated by reference in the subject applica- tion at page 20, lines 3-8. |
| 6. (Claim 71) irrigating the surgical site with a liquid medium<br><br>(Claim 76) irrigating the tissue with a liquid medium. | Page 15, lines 1-10. |

Claim 72-75, which correspond substantially to Claims 2, 3, 4, and 6 respectively of the '421 patent, do not define separate patentable inventions. Claims 72 and 73 find support in the present application at page 6, lines 6-8. Claim 74 is

supported on page 6, lines 9-11 of the present application. Claim 75 is supported at page 15, line 15 through page 17, line 8 of the present application.

The proposed count as well as applicant's Claim 71 recite the same patentable invention as Claim 1 of the '421 patent, as defined in 37 C.F.R. §1.601(n). The count and Claim 71 of the application both are supported by applicant's specification. The count is broader than Claim 1 of the '421 patent and is not narrower in any respect. Thus the count is acceptable pursuant to 37 C.F.R. §606 which only states that a count cannot be narrower than the corresponding patent claim. Since the count encompasses the broadest corresponding patentable claim of this application and the '421 patent, an interference should be declared based on the proposed count.

No prima facie showing under 37 C.F.R. §1.608 is required, since applicant's earliest effective filing date, July 31, 1985, precedes the earliest effective filing date of the application resulting in the '421 patent, which is August 19, 1988.

It is respectfully requested that the Examiner determine that an interference should be declared, and take all necessary steps for declaration of such an interference.

The specification and drawings have been amended to correct minor errors in the description of the drawing and in the reference numerals. Several reference numerals have been used more than once for different elements in the specification and

drawings. In particular, reference numerals 58, 60, 62, 64, and 68 have been used to represent three different elements in Figures 6, 7, 8, 9, 10, and 11. To correct these obvious errors, applicant has amended pages 19-23 of the specification to change some of the reference numerals. The first time one of these reference numerals appears in Figs. 6 and 7, it was left intact. However, in Fig. 8, reference numerals 60-68 were changed to reference numerals 160-168. In Figs. 9, 10, and 11, reference numeral 58 was changed to reference numeral 158, reference numeral 62 was changed to reference numeral 262, reference numeral 64 was changed to reference numeral 264, and reference numeral 60 was changed to reference numeral 260.

Proposed corresponding drawing corrections are also being submitted herewith. Attached hereto and marked in red are photocopies of Figures 8, 9, 10, and 11 indicating the requested changes to the reference numerals. Approval for these amendments to the drawings is respectfully requested.

In addition, on line 3 of page 23 of the application, the number of the patent which issued from the Sinofsky patent application referenced therein has been inserted. Also, on page 22, line 17, "its inner surface 62" was changed to--the inner surface of bore 262--for purposes of clarity.

It is submitted that the proposed changes to the specification and drawings merely correct obvious errors, and do not introduce any new matter.

It is respectfully submitted that all of the claims presently contained in the application are in condition for allowance. It is respectfully requested that an interference be declared between this application and U.S. Patent No. 5,037,421.

Respectfully submitted,

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Date: April 19, 1993

B0410/7207
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